

REJECTION UNDER 35 U.S.C. §103

The Examiner maintained the rejection of claims 1-42 under 35 U.S.C. §103(a) over JP 10158541 in view of Schmid et al. (U.S. Patent No. 5,624,486) and further in view of JP 5017710.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art references when combined must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Finally, there must be a reasonable expectation of success. M.P.E.P. § 2143 (7th ed. 2000).

Applicants respectfully traverse the rejection for the reasons of record as well those presented below. In particular, the Examiner has failed to establish that the combination of references teaches or suggests all the claim elements. Moreover, the Examiner has failed to establish that one of ordinary skill in the art would have been motivated to combine the references to achieve the claimed invention. In particular, the Examiner has failed to point to a teaching or suggestion in the references or the knowledge available to one of ordinary skill in the cosmetic art that would motivate one of ordinary skill in the art to make the combination proposed by the Examiner.

The Examiner relied on JP 101585541 for teaching that "the surface of a powder pigment base material composition of glass particles" can be coated "with a silver alloy."¹ (Office Action dated October 15, 2001, at 3.) The Examiner also relied on this

¹ An English-language translation of JP 101585541 is attached hereto as requested by the Examiners at the personal interview.

reference for providing the motivation to use the disclosed pigments due to its "weather resistance" and "glittery properties." (Id. at 5.) Specifically, the Examiner stated that "the properties taught by the ('710) Japanese document and '541 JP document are the same as that of the claimed invention." (Final Office Action dated March 4, 2002, at 2.)

The Examiner acknowledged that this reference does not teach or suggest a cosmetically-acceptable medium. (Office Action dated October 15, 2001, at 4.) The Examiner has failed to point to a teaching or suggestion in this reference that would motivate one of ordinary skill in the art to use the disclosed pigments of JP 10158541 in a cosmetic composition comprising a cosmetically-acceptable medium. Moreover, the Examiner has failed to establish how the disclosed properties in JP 10158541 would motivate one of ordinary skill in the art to use the disclosed pigment in a cosmetic composition. For example, the Examiner has failed to elucidate how "weather resistance" is a property that one of ordinary skill in the cosmetic art would be interested in achieving in a cosmetic composition. In fact, Applicants submit that properties taught by this reference, and including JP '541, are not the same as that of the claimed invention. Applicants respectfully submit that this reference is not in the filed of Applicants' endeavor, and is not reasonably pertinent to the particular problem with which Applicants are concerned. Thus, this reference is nonanalogous art and should not be a basis for rejection. MPEP §2141.01(a).

The Examiner next relied on Schmid et al. for teaching a cosmetically-acceptable medium and refers to col. 6, lines 9-42. (Office Action dated October 15, 2001, at 4.) However, the Examiner has misread the disclosure of the solvents in Schmid. This particular disclosure teaches using organic solvents in the process for producing the

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multiply coated luster pigments. (Col. 6, lines 1-8.) Schmid then discloses "[s]uitable organic solvents for this purpose." (Col. 6, line 9.) However, the Examiner has failed to point to a teaching or suggestion in Schmid wherein the organic solvents are used with the finally produced multiply coated luster pigments in a cosmetic make-up composition. In fact, a review of the examples demonstrates that the luster pigments produced are "isolated" or "dried." (See for example, col. 9, lines 24-26.)

Schmid does not teach or suggest a cosmetic make-up composition comprising a cosmetically-acceptable medium. Moreover, the Examiner has not pointed to any teaching or suggestion in Schmid which would motivate one of ordinary skill in the art to use the organic solvents used in the production process for later use in a cosmetic composition.

The Examiner then relied on Schmid for teaching the use of the luster pigments in cosmetics. (Office Action dated October 15, 2001, at 4.) However, the Examiner has failed to point to any teaching or suggestion in Schmid that would motivate one of ordinary skill in the art to (1) select glass particles, (2) coat the glass particles with at least one metallic coat, and (3) combine the coated glass particle with a cosmetically-acceptable medium, (4) to form a cosmetic composition. Schmid does not provide guidance to one of ordinary skill in the art to make all of these selections in an attempt to achieve the claimed invention.

Moreover, there is no disclosure in Schmid that would enable one of ordinary skill in the art to make the claimed cosmetic composition. The mere mention of a utility does not provide enablement to one of ordinary skill in the art, especially when the primary uses of Schmid's luster pigments, including the examples, are directed to varnishes.

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Absent an enabling disclosure of how to use the luster pigments to make a cosmetic composition, Schmid is not proper prior art and should not form the basis for a rejection.

Moreover, the Examiner relied on Schmid for teaching "metallic (luster) substrate pigment particles" and expressly lists the metals suitable for the substrate. (Id.) The Examiner has failed to point to a teaching or disclosure in Schmid that would motivate one of ordinary skill in the art to use glass particles coated with at least one metallic coat in a cosmetic make-up composition, as presently claimed.

Finally, the Examiner relied on JP 5017710 for teaching "film-forming polymers."² (Office Action dated October 15, 2001, at 4.) However, JP 5017710 does not teach or suggest a cosmetic make-up composition comprising at least one dyestuff in a cosmetically-acceptable medium. Moreover, the Examiner has not pointed to any disclosure in this reference that would motivate one of ordinary skill in the art to use these alleged "film-forming polymers" in a cosmetic composition. Presumably, this is because the reference is directed to coatings for cars and motorcycles and for this reason is nonanalogous art. The Examiner has failed to establish how a reference directed to coatings for cars and motorcycles would be useful in a cosmetic. This reference is not in the field of Applicants' endeavor or reasonably pertinent to the particular problem with which Applicants' are concerned. MPEP §2141.01(a).

In sum, Applicants acknowledge that at most JP 10158541 teaches a glass particle coated with a metallic pigment. Applicants also acknowledge that Schmid teaches that luster effect pigments may be used in cosmetics, and that organic solvents

² An English-language translation of JP 5017710 is attached hereto as requested by the Examiner at the personal interview.

may be used in the production of luster effect pigments. However, neither of these two references teaches or suggests that the pigments disclosed in JP 10158541 should or could be used in a cosmetic composition with a cosmetically-acceptable medium.

Moreover, the Examiner has failed to establish how the disclosed properties in JP 10158541 would motivate one of ordinary skill in the art to use its claimed pigment with the production organic solvents disclosed in Schmid to achieve the claimed invention. JP 5017710 does not remedy any of the deficiencies of the combination of JP 10158541 and Schmid.


CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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